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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/070,912	03/13/2002	Ove Ohman	3787-0112P	2980

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EXAMINER

CHEVALIER, ALICIA ANN

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 11/05/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/070,912

Applicant(s)

OHMAN ET AL.

Examiner

Alicia Chevalier

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 and 25-27 is/are pending in the application.
- 4a) Of the above claim(s) 1-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21 and 25-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election with traverse of Group II, claims 21 and 25-27, in Paper No. 7 is acknowledged. The traversal is on the ground(s) that the Examiner has made no attempt to apply the teachings of the Nisper reference to that of the presently claimed invention. This is not found persuasive because art is not applied at the time of a restriction and the Examiner only had the burden to show that the special technical feature did not define a contribution over the prior art.

Furthermore, since the present application was filed on the national stage under 35 USC 371, the propriety of a restriction requirement or "unity of invention" is evaluated by the criterion stated in PCT Rule 13 (or, alternatively, in 37 CFR 1.475(a)), namely, unity of invention exists between multiple inventions only when these invention share one or more "special technical features" in common with the understanding that these special technical features define a contribution which each of the invention make over the prior art. Since the special technical feature of claim 21, "a matrix with a microsturctured surface" is known in the art, it does not define a contribution over the prior art. Evidence of the special technical feature not defining a contribution over the art is seen in the 35 USC 102 rejections made below.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 1-20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Applicant timely traversed the restriction (election) requirement in Paper No. 7.

### Examiner's Comment

3. Claims 21, as currently amended, recites:

“A matrix provided with a microstructured surface,

which microstructured surface, which can be used a) for reproducing said microstructured surface in a plastic material as an inverted microstructure or b)for producing a matrix that can be used according to a),

wherein said microstructured surface comprises a first microstructured surface of a first master, and a second microstructured surface of a second master, which two surfaces are oriented adjacent to each other and facing in the same direction,

and said first and second masters on sides facing away from said first and second microstructures surfaces are covered by a first common layer pertaining to the matrix, which layer is covered by a common carrier layer.”

First, the limitation(s) “used a) for reproducing said microstructured surface in a plastic material as an inverted microstructure or b)for producing a matrix that can be used according to a)” is (an) intended use limitation(s) and is not further limiting in so far as the structure of the product is concerned. “[I]n apparatus, article, and composition claims, intended use must result in a *structural difference* between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. *If the prior art structure is capable of performing the intended use, then it meets the claim.* In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art.” [emphasis added] *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967); *In re Otto*, 312 F.2d 937, 938, 136 USPQ 458, 459 (CCPA 1963). See MPEP § 2111.02.

Second, the limitations referring the first and second master are referring the apparatus, which provides the matrix with a microstructured surface (see the specification page 12, line 6+). The apparatus used in the method of forming the product is not germane to the issue of patentability of the product itself unless the apparatus used in the process results in a patentably

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distinct structure. The determination of patentability for a product-by-process claim is based on the product itself and not on the apparatus for production or the method of production . MPEP §2113. Furthermore, the limitation “said first and second masters on sides facing away from said first and second microstructures surfaces are covered by a first common layer pertaining to the matrix, which layer is covered by a common carrier layer” is considered to modify the apparatus of making the article, not the article.

In conclusion, the claim 21 is only structurally reciting a matrix article comprising a microstructure surface, where the microstructure surface comprises two adjacent microstructures. However, the Examiner notes that the claim does not specify whether the microstructures are the same or different. For purposes of examination a matrix material with a microstructure surface will read on this limitation, since the two microstructures can be the same. Exception for claim 27, which recites “wherein said first and second surfaces are of different kinds.”

Claims 25-27 have been treated the same way, i.e. limitations directed to the apparatus used in the method of forming the product are not germane to the issue of patentability of the product itself unless the apparatus used in the process results in a patentably distinct structure.

Also, purposes of examination the word matrix is used to refer to a “plastic composite,” as defined in the specification on page 5, lines 31-37.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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5. Claims 25-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The terms "type" and "kinds" used in claims 25-27 are unclear which render the claims vague and indefinite. The addition of the word "type" or "kind" to an otherwise definite expression extends the scope of the expression so as to render it indefinite.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 21 and 25-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Furthey et al. (5,840,407).

Furthey discloses a matrix (col. 3, lines 52-55) provided with a microstructured surface (col. 7, lines 55-65). The microstructured surface has a first and second microstructured surfaces (reference #110 and #112) that are oriented adjacent to each other facing in the same direction. The first and second microstructured surfaces have different structures/"kinds," i.e. a first and second type of microstructure. See figure 7.

8. Claims 21, 25 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Hwang et al. (4,902,553).

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Hwang discloses a matrix (col. 4, lines 29-44) provided with a microstructured surface (col. 6, lines 16-41). The microstructured surface has a first and second microstructured surfaces that are oriented adjacent to each other facing in the same direction. The first and second microstructured surfaces have a first and second type of microstructure, which are the same. See the figures.

***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (703) 305-1139. The Examiner can normally be reached on Monday through Thursday from 8:00 a.m. to 5:00 p.m. The Examiner can also be reached on alternate Fridays

If attempts to reach the Examiner are unsuccessful, the Examiner's supervisor, Harold Pyon can be reached by dialing (703) 308-4251. The fax phone number for the organization official non-final papers is (703) 872-9306. The fax number for after final papers is (703) 872-9311.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose phone number is (703) 308-0661.

ac

10/30/03

  
HAROLD PYON  
SUPERVISORY PATENT EXAMINER

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11/3/03